



Application No.: 10/069,116
Examiner: Monica Smith Carter
Art Unit: 3722

REMARKS

Reconsideration of the present application is respectfully requested on the basis of the following particulars.

1. In the Specification

In the Office Action, the specification was objected to on the basis that it lacked appropriate section headings. In the amendment of the specification, the specification has been amended to include the appropriate section headings. Acceptance of the amendment to the specification is requested in the next communication from the Examiner.

2. In the Claims

In the amendment of the claims, the preliminary amendment which was filed on February 28, 2002 has been resubmitted as if the preliminary amendment had never been entered. It will be noted that according to a copy of the file history of the present application at the U.S. Patent and Trademark Office that the Applicant has obtained, the preliminary amendment exists in the file history. It appears that during the course of examination of the present application, the preliminary amendment was overlooked or unavailable. As a courtesy, a copy of the preliminary amendment as originally filed and a copy of the Article 34 amendment is included herewith.

It appears that the claims that were examined and listed in the outstanding Office Action were those that were originally filed in the corresponding PCT application to the present application. It will be noted that the originally filed PCT claims were amended during preliminary examination under PCT Article 24. The amended claims in the preliminary amendment were those that were annexed to the International Preliminary Examination Report.

The claims that were annexed generally correspond in subject matter to claims 1-41 originally filed in the PCT application with the exception of claims 30-39. The subject matter of claim 30 generally corresponds to the subject matter of original claims 30-32, and the remaining claims generally correspond in subject matter to original claims 33-41. Thus, claims 30-41 identified in the outstanding Office Action do not numerically correlate to the claims that were cited in the preliminary amendment.

It will be noted that claims 3 and 30 are currently amended over the version originally presented in the preliminary amendment. More specifically, claim 3 recites "and/or magnetic pigments" to maintain consistency with claim 2 wherein "magnetic properties" is already recited. Furthermore, claim 30 has been revised by moving the phrase "contains liquid crystal pigments" to another location within the claim to improve the clarity thereof.

In both the preliminary amendment and amendment to the claims 3 and 30, the amendments have been submitted to improve the clarity of the subject matter for which protection is sought or to remove multiple dependencies in the claims. The amendments were not made to avoid prior art, as it is believed that the original claims are fully patentable over the cited prior art. Rather, in reviewing the claim language it was perceived that some of the language could be improved to more clearly define the inventive subject matter. It is to be noted that the Examiner did not raise any objections with regard to the language of the original claims under 35 U.S.C. § 112 or any other part of the patent laws and regulations.

Acceptance of the amendment of the claims as presented in the List of Current Claims is respectfully requested in the next communication from the Examiner.

3. Rejection of claims 1-6, 15, 20, 23, 24, 26-31 and 38-41 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent 5,883,043 (Halbrook, Jr. et al.)

Claims 1-6, 15, 20, 23, 24, 26-31 and 38-41 are currently rejected in view of the Halbrook, Jr. et al. disclosure. The rejection of these claims in view of the Halbrook, Jr. et al. disclosure is respectfully traversed on the basis of the following observations.

a. Claims of the present application

Claim 1 of the present application generally recites an object of value having features to increase protection from forgery. The object of value comprises a thermochromic layer that is combined with an additional optically effective effect layer having visually and/or machine testable properties. Claims 2-29 depend either directly or indirectly from the basic embodiment recited in claim 1.

As noted above, claims 30-41 do not numerically correlate with those currently presented in the amendment to the claims. Claim 30 presently recites the subject matter of original claims 30, 31 and 32. Of particular note, claim 32 was not rejected in view of the teachings of Halbrook, Jr. et al., and current claims 31-39 depend from claim 30.

Accordingly, the remainder of the discussion will be devoted to claims 1-29 since it appears that the rejection of claims 30-41 is moot.

b. The Halbrook, Jr. et al. disclosure

The Halbrook, Jr. et al. disclosure describes a thermal paper having security features comprised in a water-based security ink including optically variable pigments and dyes such as those that are thermochromic, photochromic or fluorescent (col. 3, lines 1-5). The security ink visually determines the authenticity of the document and has more than one means of security.

As plainly described in its abstract, the Halbrook, Jr. et al. disclosure states that the thermal paper includes security features from the water-based security ink

that includes a variable light absorbing and/or transmitting pigment or dye in the ink as a first security feature, and a water repelling agent in the ink as a second feature. In each of the security features, it is abundantly clear that the features are inks and not layers as recited in the claims of the present application. Moreover, in light of the Halbrook, Jr. et al. disclosure, even in the specific case where thermochromic pigments are contained in the ink, the second security means always forms part of the same security ink (see claim 1 of the Halbrook, Jr. et al. disclosure).

As a side note, it appears that the term “thermosensitive” used in the Halbrook, Jr. et al. disclosure has been confused with the term “thermochromic” employed in the context of the present application. The thermosensitive surface of the thermal paper described in the Halbrook, Jr. et al. disclosure changes its color at a certain temperature once and forever (col. 4, lines 9-32). On the other hand, in accordance with the present application, thermochromic material is distinguished by changing color dynamically. The definition of thermochromic or thermochromism is consistent with the meaning provided in Webster’s Third New International Dictionary which defines thermochromism as a “phenomenon of reversible change of color of a substance with change of temperature.”

Thus, in view of these observations, the claims of the present application recite a thermochromic layer that is combined with an additional, optically effective effect layer. The Halbrook, Jr. et al. disclosure simply fails to teach this feature of the pending claims of the present application. Since a combination of two different layers is not disclosed or suggested by the Halbrook, Jr. et al. disclosure, it is respectfully submitted that claim 1 is not anticipated by the Halbrook, Jr. et al. disclosure. The rejected claims dependent from claim 1 are likewise patentable based on their dependency from claim 1 and their individually recited features.

4. Conclusion

In view of the amendment of the claims, and further in view of the foregoing remarks, it is respectfully submitted that the application is in condition for allowance. Accordingly, it is respectfully requested that each and every pending claim in the present application be allowed and the application be passed to issue.

If any issues remain that may be resolved by a telephone or facsimile communication with the Applicant's Attorney, the Examiner is invited to contact the undersigned at the numbers shown below.

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Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Justin J. Cassell', written in a cursive style.

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